APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,478	03/13/2001	Makoto Suzuki	1614.1135	8768

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EXAMINER	
JAMAL, ALEXANDER	

ART UNIT	PAPER NUMBER
2614	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	09/804,478	SUZUKI, MAKOTO
	Examiner	Art Unit	
	Alexander Jamal	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **3** MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 December 2006*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) _____ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-6,15-19 and 21-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

       1.☒ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   Examiner notes the amendment filed 12-22-2006 is entered via RCE, claims 1,3-6,16-19,21,22,27-29 have been amended and claims 2,7-14.20 are cancelled.

2.   Examiner notes the following multiple rejections:

Claims 21-26 have been rejected by Beatty in view of Shaffer and again by Beatty in view of Walsh and claim 21 again by Shojiro.

Claims 27-28 have been rejected by Beatty in view of Walsh and again by Walsh and again by Shojiro and again by Tomohiro.

Claims 1,6,18,19 have been rejected by Tomohiro in addition to the maintained previous rejection.

Claim 29 has been rejection by Shojiro and again by Beatty in view of Walsh.

Information Disclosure Statement

1.   The information disclosure statements filed 2-1-2007, 2-16-2007 fail to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. They have been placed in the application file, but the information referred to therein has not been considered.

2. Examiner notes that any of the modes, phone directories or selectable functions of the devices disclosed by the prior art listed in the 1-29-07 or 12-22-2006 IDS submissions may also read on applicant's claims as they are all implemented with software (application programs).

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 18,19** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per **claims 18 and 19,** each claim recites "that are managed by the managing". It is not clear what "the managing" refers to. For the purpose of examination, examiner assumes the claims refer to managing by the controlling software of the device.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.   **Claims 1,3,4,18,** rejected under 35 U.S.C. 102(b) as being anticipated by Beatty et al.

(5675630).

As per **claim 1,** Beatty discloses a mobile phone comprising a managing part

(software in the phone) that manages functions and information (application programs) in

a manner linked to a plurality of using situations. Since the device is controlled with

software, each and every function or mode of the device (different phone directories for

example) is considered an 'application program'. The software will associate different

speed dial directories with different using situations (NAMS) (ABSTRACT). The device

further comprises a switch usable by the caller to activate a specific NAM (set a specific

using situation) (Col 4 lines 25-35). Each NAM setting is a mode (one of a plurality of

modes/using situations) useable by the user. The use of different NAMs allows the

phone to be used in a business or personal situation (Col 2 lines 20-35). The device

further comprises a control part (software) that will automatically select the appropriate

function and information depending on the using situation, and make the information

available to the user (abstract, Col 4 lines 45-65). Once a NAM is activated by user

selection, the application software will automatically activate a phonebook and/or speed

dial function corresponding to the selected NAM. The NAM specific phonebook and/or

speed dial function are the functions and information (application programs) that are

automatically activated for use by the user. Since the using situation may be set by the

user, the user is 'responsive to detection of said using situation based on a current use

pertaining to said one or more application programs" because the user is able to detect the

current using situation based on his/her current use (what mode the user has activated).

Each an every mode will pertain to whichever application program is used to implement that particular mode. Once a rule has been met (for example: by activating the switch), then the appropriate application and information (the phonebook and/or speed dial function) are triggered and presented to the user (Col 4 lines 25-35). The purpose of the system is to associate and provide information (telephone number directories) to the user based upon the selected NAM (mode) of the phone. The information provided has a high probability of use by a user of a particular NAM mode since that particular NAM was selected by the user.

As per **claim 18,** Beatty discloses information terminal equipment that includes a computer using a computer readable medium that stores a program comprising a managing means (software) that manages functions and information (application programs) in a manner linked to a plurality of using situations. The software will detect various parameters from the caller and manage the transfer of information to/from the caller as described in the rejections of claim 1.

As per **claim 3,** the NAM chosen (operating mode) can be applied to accounting (billing) destinations (Col 1 lines 15-35).

As per **claim 4,** the portable phone comprises a display and the appropriately selected phone directory/NAM information (with each directory being implemented with the controlling application program.

5.   **Claims 27,28** rejected under 35 U.S.C. 102(b) as being anticipated by Walsh (5642410).

        As per **claims 27 and 28,** Walsh discloses a telecommunications terminal that

automatically provides the appropriate application program (setting the appropriate

mode) to a user based upon the incoming or outgoing call information (Col 8 line 55 to

Col 9 line 25). Since the device is controlled with software, each and every function of

the device (different phone directories for example) is considered an 'application

program'. The mode-associated information is classified in a mode because it has a high

possibility of being used for that particular mode.

6.   **Claims 1,6,18,19,27,28** rejected under 35 U.S.C. 102(b) as being anticipated by

Tomohiro ('Patent Abstracts of Japan' publication: 09-107396).

        As per **claim 1,** Tomohiro discloses a portable device that is able to classify data

(phone directory data) and retrieve various sets of data via a control section (abstract).

Each set of retrieved information is displayed to the user. Each set of retrieved

information is considered a 'mode' of operation for the device. Since the device is

controlled with software, each and every function of the device (different phone

directories for example) is considered an 'application program'. The device inherently

comprises a managing part controlling a switch and a control part for the purposes of

performing the aforementioned functions (examiner reads a switch as any function that

enables the different directories to be retrieved) (examiner reads a control part as any

function that performs the logic of selecting one set of data over another). Since the

using situation may be set by the user, the user is 'responsive to detection of said using

situation based on a current use pertaining to said one or more application programs"

because the user is able to detect the current using situation based on his/her current use

(what mode the user has activated). Each an every mode will pertain to whichever

application program is used to implement that particular mode.

As per **claim 6,** claim rejected for the same reasons as claim 1. The classified data

is retrieved depending on data from a control channel being setup. A control channel

would be setup anytime a transmission or reception was made from/to the terminal.

As per **claims 18,19** Tomohiro's device inherently comprises software on a

readable medium for the purpose of controlling the device hardware.

As per **claims 27, 28,** claims rejected for the same reasons as claim 1. The

terminal is operated to retrieve data based on the currently selected mode (business or

private). The data assigned to each mode is inherently classified in accordance with a

possibility of occurrence for it's corresponding mode by the definition of the specific

'mode' (ie. each 'mode' is defined by the function that may possibly be performed while

in that particular 'mode'). Since the device is controlled with software, each and every

function of the device (different phone directories for example) is considered an

'application program'.

7.   **Claims 21,27-29** rejected under 35 U.S.C. 102(b) as being anticipated by Shojiro ('Patent

Abstracts of Japan' publication: 10-304452).

As per **claims 21,29,** Shojiro discloses a portable device that stores data used for

various functions (displaying and dialing stored phone numbers). Since the device is

controlled with software, each and every function of the device (different phone

directories for example) is considered an 'application program'.   The data is classified

by and retrieved according to detected time and location information for the terminal

(ABSTRACT). The device inherently comprises a managing part controlling a switch

and a control part for the purposes of performing the aforementioned functions (examiner

reads a switch as any function that enables the different directories to be retrieved)

(examiner reads a control part as any function that performs the logic of selecting one set

of data over another). The device further inherently comprises a timer for the purpose of

detecting the time.

As per **claims 27, 28,** claims rejected for the same reasons as claim 1. The

terminal is operated to retrieve data based on the currently selected mode (business or

private). The data assigned to each mode is inherently classified in accordance with a

possibility of occurrence (displayed with priority) for it's corresponding mode by the

definition of the specific 'mode' (ie. each 'mode' is defined by the function that may

possibly and most likely be performed while in that particular 'mode').

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9.   **Claims 6,19, 15-16,21-29** rejected under 35 U.S.C. 103(a) as being unpatentable over

Beatty et al. (5675630), and further in view of Walsh (5642410).

As per **claim 6,** the claim is rejected for the same reasons as the rejection of claim

1. Additionally, Beatty discloses a detector that detects several pieces of 'mode -

information' (example: caller's location) to set a specific using situation (Col 2 line 64 to

Col 3 line 10). Since the device is controlled with software, each and every function of

the device (different phone directories for example) is considered an 'application

program'.   The device further comprises a control part (software) that will

automatically select the appropriate function and information depending on the using

situation, and make the information available to the user (Col 4 lines 25-35). Once a rule

has been met (for example: by activating the switch), then the appropriate application and

information are triggered and presented to the user. Beatty discloses that the NAM

modes may be selected manually by the user (Col 4 lines 35-45). However, Beatty does

not disclose that the NAM modes are triggered according to one of an email or telephone

address belonging to a contacted party.

Walsh discloses a telecommunications terminal that automatically provides the

appropriate information (using mode) to a user based upon the incoming or outgoing call

information (Col 8 line 55 to Col 9 line 25). Walsh teaches that this computer-telephone

integration system can save time (Col 1 lines 15-30). It would have been obvious to one

of ordinary skill in the art at the time of this application that incoming or outgoing

telephone numbers could be used as triggers to activate the various NAM modes of

Beatty's system for the purpose of saving the user the time of having to manually activate

the appropriate mode.

As per **claim 19,** claim rejected for same reasons as rejections of claims 6.

Examiner notes that the 'mode information' recited in the claim may be the user selection

(via incoming or outgoing telephone numbers for example) of the preferred NAM of

Beatty's system.

As per **claims 21,** claim rejected for the same reasons as claim 6. Additionally,

Walsh discloses that one of the triggers may be the time of day (Col 2 lines 45-55). In

.order to detect the time of day the device inherently comprises a timer. One NAM may

be considered the 'business mode' while another NAM may be considered a 'private

mode'.

As per **claims 27,28,** claim rejected for same reasons as claim 1. The phone user

may enter in additions to the speed dial directory (via editing) (Col 6 lines 55-65). The

phone will classify the phone directory entries that are executed as being associated with

the NAM that is currently active (a first or second operating mode). The terminal is

controlled to select the appropriate NAM (switch between operating modes) when the

associated number is called or received.

As per **claim 29,** claim rejected for the same reasons as claim 6. Beatty discloses

that the NAM mode may be triggered by detecting communication channels. The

examiner reads detecting communication channels as detecting the location of the device
(ie. a location may be defined by it's communication channels) (BEATTY: Col 3 lines 1-
10). The first and second set or procedures are the control functions used to activate the
corresponding phonebook/speed dial list for each NAM. The controlling software will
modify the function (phonebook/speed-dial) and the appropriate list of names/numbers
can be displayed to the user (displaying an application program) (BEATTY: Col 6 lines
55-65).

As per **claims 15,** the NAM chosen (operating mode) can be applied to
accounting (billing) destinations (Col 1 lines 15-35).

As per **claims 16,** the portable phone comprises a display and the appropriately
selected phone directory/NAM information (function,/application program).

As per **claims 22,23,** Beatty's system displays the appropriate information based
upon the selected mode (NAM).

As per **claim 24,26,** claim rejected for same reasons as claim 1.

As per **claim 25,** Beatty discloses that the NAM mode may be triggered by
detecting communication channels. The examiner reads detecting communication
channels as detecting the location of the device (ie. a location may be defined by it's
communication channels) (BEATTY: Col 3 lines 1-10).

10.   **Claim 5,** rejected under 35 U.S.C. 103(a) as being unpatentable over Beatty et al.
(5675630) as applied to claim 1 above, and further in view of Bijman (6047062).

As per **claim 5,** Beatty and Walsh discloses applicant's claims 1, but does not specify that the managing part automatically updates the data that depends upon the using situation and is not already included in the database.

Bijman teaches a method of automatically updating information stored in a database used in a telephone system (speed dialing system). He teaches the advantage of saving the user the trouble of manually updating the database (Col 1 lines 14-30) by having the phone system automatically add data (a new phone number) to the database. It would have been obvious to one of ordinary skill in the art at the time of this application to have the managing part automatically update the appropriate database for the advantage of saving the user the trouble of manually updating the database.

11.   **Claim 17** rejected under 35 U.S.C. 103(a) as being unpatentable over Beatty et al. (5675630) in view of Walsh (5642410) as applied to claim 6 above, and further in view of Bijman (6047062).

As per **claim 17,** Beatty and Walsh discloses applicant's claim 6, but do not specify that the managing part automatically updates the data that depends upon the using situation and is not already included in the database.

Bijman teaches a method of automatically updating information stored in a database used in a telephone system (speed dialing system). He teaches the advantage of saving the user the trouble of manually updating the database (Col 1 lines 14-30) by having the phone system automatically add data (a new phone number) to the database. Since the device is controlled with software, each and every function of the device

(different phone directories for example) is considered an 'application program'.   It
would have been obvious to one of ordinary skill in the art at the time of this application
to have the managing part automatically update the appropriate database for the
advantage of saving the user the trouble of manually updating the database.

12.   **Claims 21-26** rejected under 35 U.S.C. 103(a) as being unpatentable over Beatty et al.
(5675630), and further in view of Shaffer et al (6477374).

As per **claims 21,25,** Beatty discloses claims 21,25 for the same reasons as the
rejections of claims 1 and 6, but does not specify that the terminal equipment detects the
using situation based upon time information.

Shaffer teaches a device (cellular phone) system that cross references a date and
time (to reference a time the unit inherently comprises a timer) with a user's location so
that a call may be routed or forwarded (ie. a different using situation is setup) based upon
a user's location (Col 2 line 45 to Col 3 line 7). He teaches the advantage that a user may
be more easily tracked down even if he/she forgot to leave a forwarding number (Col 2
lines 23-43), as well as the advantage of more efficient call routing (Col 1 lines 44-55).
The activation of the NAM mode is based upon the appropriate location, which is based
upon the time of day. It would have been obvious to one of ordinary skill in the art at the
time of this application to detect a user's time-location in order to set the using state
(NAM selection) for the advantage of being able to more easily track down a user and
being able to more efficiently route or handoff the call (the handoff is more efficient
because the user may be able to use local access is the appropriate NAM is selected).

As per **claims 22,23,** Beatty's system displays the appropriate information based upon the selected mode (NAM).

As per **claim 24,26,** claim rejected for same reasons as claim 1.

Response to Arguments

3.   Applicant's arguments filed 12-22-2006 have been fully considered but they are not persuasive.

As per applicant's arguments that the cited references do not disclose application programs as recited in the claims, examiner contends that since the device is controlled with software, each and every function of the device (different phone directories for example) is considered an 'application program'. Applicant is using the term 'application program' to refer to software implemented 'modes' of operation that enable one phone directory or another to be accessable. The cited prior art is performing the same functions.

As per applicants request for examiner to produce authority for his statement regarding the Tomohiro reference (arguments page 9). Examiner notes that since the device is controlled with software, each and every function or mode of the device (different phone directories for example) is considered an 'application program'. Equipment that transfers and stores digital data requires software to control the hardware. Any portion of the software that controls or sets the functions disclosed by Tomohiro is a 'managing part'. Since the device of Tomohiro is able to **switch** between modes of

operation it requires a device to 'switch' the modes. Examiner reads a switch as any function that enables the different directories to be retrieved, and examiner reads a control part as any function that performs the logic of selecting one set of data over another.

As per applicants argument that the cited references do not disclose a 'business mode' or 'personal mode' as claimed in claim 3 (arguments page 10), examiner notes that the cited prior art discloses different operating modes. Either mode may arbitrarily be considered a 'business' mode while the other is considered a 'personal' mode. Each mode is a distinct mode that is enabled by a certain condition (a switch being actuated by the user for example). The user may arbitrarily determine which mode is for business and which mode is for personal use. Threre is no defining criteria for what 'personal use' or 'business use' entails in applicant's specification. The two terms merely signify that two different modes are being used for two different situations. Examiner further notes the Tomohiro reference which further discloses the use of 'personal' and 'business' directories in cell phones.
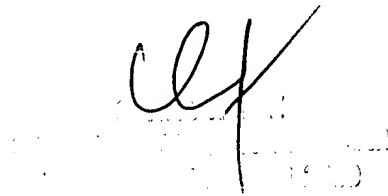
As per applicants arguments that the cited references do not disclose detecting the 'use' of the terminal and selecting the appropriate application program (arguments page 11), examiner notes the above responses to arguments. The 'use' is detecting by any of the mechanisms noted above in the rejections (a switch, or a location, or a date/time, or a location of the device). Since the device is controlled with software, each and every function or mode of the device (different phone directories for example) is considered an 'application program'.

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Alexander Jamal whose telephone number is 571-272-7498. The
examiner can normally be reached on M-F 9AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Curtis A Kuntz can be reached on 571-272-7499. The fax phone numbers for the
organization where this application or proceeding is assigned are **571-273-8300** for regular
communications and **571-273-8300** for After Final communications.

AJ
March 19, 2007